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10/822,224

04/09/2004

Jurgen Baus

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HENRY M FEIEREISEN, LLC
350 FIFTH AVENUE
SUITE 4714
NEW YORK, NY 10118

EXAMINER

TIV, BACKHEAN

ART UNIT

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2151

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,224

Applicant(s)

BAUS ET AL.

Examiner

Backhean Tiv

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/04, 11/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Detailed Action

Claims 1-23 are pending in this application.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/9/04, 11/17/05 have been considered. However, Foreign Patent DE 19904331 C1 was not considered since there was no translation.

Drawings

The Drawings filed on 4/9/04 are acceptable.

Specification

The disclosure is objected to because of the following informalities:

The applicant did not include co-pending application 10/822,227 in paragraph 0001 of the specification.

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Communication between devices with different protocols.

Double Patenting

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A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 11 of copending Application No. 10/822,227. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 23 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/822,227. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of copending application 10/822,227 teaches all the limitations of claim 23 of the present application. The only difference between the present application and the copending application is, the copending application has "data exchanged between the at least one automation device and the data conversion unit and **between** the automation device"; while, the present application, has "data exchanged between the at least one automation device and the data conversion unit and **among** the automation device". It is obvious to one ordinary skill in the art that if a device is between another device that it is also among devices.

Claims 9, 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,11 of copending Application No. 10/822,227 in view of US Patent 6,785,730 issued to Taylor. Claims 1,11 of copending application 10/822,227 teaches all the limitations of claims 9,16 of the present application except for wherein the first communication protocol enables both markup data transmission and a binary data transmission, wherein the devices between which data are exchanged decide at the beginning of the data transmission automatically if the markup data transmission or the binary data transmission is to be used; transmitting quality data in the first transmission protocol, and deciding based on the quality data how data are to be transmitted between the data conversion unit and the remote unit by using the second communication protocol.

Taylor teaches, wherein the first communication protocol enables both markup data transmission and a binary data transmission, wherein the devices between which data are exchanged decide at the beginning of the data transmission automatically if the markup data transmission or the binary data transmission is to be used(col.8, lines 22-40, col.9, lines 30-52, col.11, lines 5-20); transmitting quality data in the first transmission protocol, and deciding based on the quality data how data are to be transmitted between the data conversion unit and the remote unit by using the second communication protocol(col.5, lines 1-67).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of copending application 10/822,227 to include the first communication protocol enables both markup data transmission and a binary data transmission, wherein the devices between which data are exchanged decide at the beginning of the data transmission automatically if the markup data transmission or the binary data transmission is to be used; transmitting quality data in the first transmission protocol, and deciding based on the quality data how data are to be transmitted between the data conversion unit and the remote unit by using the second communication protocol as taught by Taylor in order to provide a system to transmit information using different protocols.

One ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of copending application 10/822,227 and Taylor in order to provide a robust infrastructure enabling client-server vendors to send and receive data.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,785,730 issued to Taylor in view of US Publication 2001/0025322 issued to Song et al.(Song).

As per claim 1,9,16, Taylor a method for data transmission to access from a remote unit to at least one automation device(Abstract), comprising the steps of:

a) transmitting the data between the remote unit and the at least one automation device by connecting a data conversion unit there between(Fig.1);

b) exchanging the data between the at least one automation device and the data conversion unit and between the automation devices according to a first communication protocol(Fig.1, col.3, lines 27-38), wherein the first communication protocol enables both markup data transmission and a binary data transmission, wherein the devices between which data are exchanged decide at the beginning of the data transmission automatically if the markup data transmission or the binary data transmission is to be used(col.8, lines 22-40, col.9, lines 30-52, col.11, lines 5-20);

c) exchanging the data between the data conversion unit and the remote unit according to a second communication protocol(Fig.1, col.5, lines 1-34); and

d) causing the data conversion unit to convert the data according to the first communication protocol into the data according to the second communication protocol(Fig.1, col.5, lines 1-34).

e) transmitting quality data in the first transmission protocol, and deciding based on the quality data how data are to be transmitted between the data conversion unit and the remote unit by using the second communication protocol(col.5, lines 1-67).

Taylor does not explicitly teach a web server.

Song teaches a web server(Abstract).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Taylor to include a web server as taught by Song in order to control devices through a web page(Song, para.0011).

One ordinary skill in the art would have been motivated to combine the teachings of Taylor and Song in order to provide a system to control non IP-based network devices with IP-based network devices(Song, para.0011).

As per claim 2, the method of claim 1, wherein the first communication protocol enables both markup data transmission and binary data transmission, wherein the devices and units between which data are exchanged decide at the beginning of the data transmission automatically if the data are to be transmitted by markup data transmission or by binary data transmission(Taylor, col.8, lines 22-40, col.9, lines 30-52, col.11, lines 5-20).

As per claim 3, the method of claim 2, wherein both the markup data transmission and the binary data transmission of the first communication protocol are instruction-based(Taylor, col.9, lines 30-51, col.11, lines 1-20, Song, Abstract).
Motivation to combine set forth in claim 1.

As per claim 4, the method of claim 2, wherein the markup data transmission can be converted into the binary data transmission and the binary data transmission can be converted into the markup data transmission(Taylor, col.9, lines 30-51, col.11, lines 1-20).

As per claim 5, the method of claim 2, wherein the data are exchanged between the automation devices by using the binary data transmission of the first communication protocol(Taylor, col.9, lines 30-51).

As per claim 6, the method of claim 2, wherein the data are exchanged between the at least one automation device and the data conversion unit preferably by using the markup data transmission of the first communication protocol(Taylor, col.11, lines 1-20).

As per claim 7, the method of claim 1, wherein quality data are transmitted both in markup data transmission and in binary data transmission, with the quality data determining if the data are to be transmitted between the data conversion unit and the remote unit in markup data transmission and in binary data transmission(col.5, lines 1-67).

As per claim 8, the method of claim 1, wherein the second communication protocol is a Web-based, instruction-based protocol(Taylor, col.11, lines 1-20, Song, Abstract). Motivation to combine set forth in claim 1.

As per claims 10-15, 17-22, do not teach or further define over the limitations in claims 1-8,9,16. Therefore 10-15, 17-22 are rejected for the same reasons set forth above.

As per claim 23, Taylor teaches a data transmission device for accessing from a remote unit at least one automation device(Abstract), comprising a data conversion unit connected between the remote unit and at least one automation device and configured to convert data between a first communication protocol and a second communication protocol(Abstract, col.3, lines 24-37), wherein the data are exchanged between the at least one automation device and the data conversion unit and between the automation devices by using the first communication protocol(col.5, lines 1-34), and wherein the data are exchanged between the data conversion unit and the remote unit according to a second communication protocol(col.7, lines 40-50).

Taylor does not explicitly teach a web server.

Song teaches a web server(Abstract).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Taylor to include a web server as taught by Song in order to control devices through a web page(Song, para.0011).

One ordinary skill in the art would have been motivated to combine the teachings of Taylor and Song in order to provide a system to control non IP-based network devices with IP-based network devices(Song, para.0011).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571) 272-5654. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Wallace can be reached on (571) 272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



BackheanTiv
2151
8/23/07



VALENCIA MARTIN-WALL
PRIMARY EXAMINEE